

REMARKS

This is in response to the Office Action dated 13 August 2003. Reconsideration is respectfully requested.

In this amendment, claim 3 has been cancelled without prejudice or disclaimer, claims 1, 4, 5 and 8 have been amended, and new claims 22-29 have been added. No new matter has been added. Claims 1-10 and 12-29 are currently pending in the application.

In paragraph 3 on page 2 of the Office Action, claims 1-2, 6-9, 12 and 18-21 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,951,970 (Burt). Burt is asserted to teach a label such that the label and a protective plastic laminate are located on opposite sides of a backing layer. There is a split-line in the backing layer. When the device is separated along the split line, the label comes off completely backed by a section of the backing layer, so that no adhesive is exposed. The laminate comes off largely backed by a different section of the backing layer, so that the adhesive is partially exposed.

To anticipate a claim, a reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the reference to maintain a rejection based on 35 U.S.C. §102. The Applicant respectfully submits that Burt does not teach every element of independent claims 1, 8 and 14, in view of the amendments made to claim 1, and therefore fails to anticipate claims 1, 8 and 14. Of course, it is always necessary to deal with a possible sec 103 combination rejection and that is addressed elsewhere herein.

Claim 14 and amended claims 1 and 8 include a backing member that contains a split-line, wherein the label and the laminate both straddle the split-line. Again, Burt is asserted to teach a backing member that contains a split-line, but notice that Burt has

only the backing member straddling the split-line; the label is located entirely on one side of the split-line.

This distinction is significant to the present invention. Accurate placement of a label on a folder is important for the readability thereof. Yet it is very tricky to do so with the label be naturally very sticky and removal thereof, once placed, such as on a paper file, will destroy the file and the label. Consequently, improvements, which aid in correct placement of the label, are particularly important.

When the user separates the two portions of the device, it is advantageous to have regions of both exposed and unexposed adhesive on both the label and the laminate. The unexposed portions, protected by the backing layer, aid the user when affixing the label, and may protect against undesirable adhesion to the file folder or to fingers. The Applicant respectfully traverses the rejection because the cited reference fails to disclose all the claim features.

Claim 18 teaches removal of the label by separating the backing layer along the split-line, which can only occur if the label straddles the split-line. As discussed above, the label in Burt is located entirely on one side of the split-line, and cannot be removed by separating the backing layer along the split line. The Applicant respectfully traverses the rejection because the cited reference fails to disclose all the claim features.

Dependent claims 2, 6, 7, 9, 12 and 19-21, which are dependent from claims 1, 8, 14 and 18, were also rejected under 35 U.S.C. §102(b) as being anticipated by Burt. While the Applicant does not acquiesce to the particular rejections to these dependent claims, it is respectfully asserted that these rejections are moot in view of the remarks made in connection with independent claims 1, 8, 14 and 18. These dependent claims include all of the features of the base claims and any intervening claims, and recite additional features that further distinguish these claims from the cited reference. Therefore, dependent claims 2, 6, 7, 9, 12 and 19-21 are also in condition for allowance. In addition, each of the dependent claims recites additional structure, which taken in combination present new and unobvious combinations in their own right. As these claims have never been rejected in their present combination, no further discussion thereof is warranted at this time. The Applicant respectfully requests that the rejections be withdrawn and the application passed to issue.

In paragraph 4 on page 2 of the Office Action, claims 8, 10 and 12 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 3,924,744 (Heimann). Heimann has been asserted to teach a label with a split-line in the backing layer, so that when the device is separated along the split-line, the label comes off such that the adhesive is partially exposed. There is no mention of any transparent laminate at all in Heimann. Independent claim 8 calls for both a label and a laminate, with each straddling the split-line in the backing layer. Because Heimann does not teach a laminate, the Applicant respectfully submits that Heimann does not teach every element of independent claim 8 and therefore fails to anticipate claim 8.

Dependent claims 10 and 12, which are dependent from claim 8, were also rejected under 35 U.S.C. §102(b) as being anticipated by Heimann. While the Applicant does not acquiesce to the particular rejections to these dependent claims, it is respectfully asserted that these rejections are moot in view of the remarks made in connection with independent claim 8. These dependent claims include all of the features of the base claims and any intervening claims, and recite additional features that further distinguish these claims from the cited reference. In addition, each of the dependent claims recites additional structure, which taken in combination present new and unobvious combinations in their own right. As these claims have never been rejected in their present combination, no further discussion thereof is warranted at this time. Therefore, dependent claims 10 and 12 are also in condition for allowance. The Applicant respectfully requests that the rejections be withdrawn and the application passed to issue.

In paragraph 6 on page 3 of the Office Action, claims 1-10 and 12-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Burt in view of Heimann. The Applicant respectfully traverses the rejections.

Three criteria must be met to establish a *prima facie* case of obviousness. *First*, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. *Second*, there must be a reasonable expectation of success. *Third*, the prior art reference, or combination of references, must teach or suggest all the claim

limitations. MPEP §2142. The Applicant respectfully traverses the rejection because the cited references fail to disclose all the claim features.

The Applicant's invention as set forth in independent claims 1, 8, 14 and 18 is different from a combination of Burt and Heimann. As discussed above, Burt fails to teach that the label and the laminate both straddle the split-line. Also as discussed above, Heimann fails to teach a transparent laminate, teaching only a label that straddles a split-line in the backing layer.

The Burt references fails as a basis for a sec. 103 rejection because it fails to even recognize the problem solved by the present invention with respect to providing a non-sticky surface to hold the label during placement on the receiving surface. The other references cited fail for similar reasons. Using the Office's own standard for patentability, in MPEP Sec 2142, the sec 103 rejection cannot be sustained.

The Applicant respectfully asserts that one skilled in the art would not combine Burt and Heimann to produce a label structure in which both the label and the laminate straddle the split-line in the backing layer. Indeed, because Heimann was well known by the time of Burt's invention, the fact that Burt chose to locate the label entirely on one side of the split-line demonstrates that the Applicant's invention is not obvious. The Applicant respectfully requests that rejections of the independent claims be immediately withdrawn and the application passed to issue.

Dependent claims 2-7, 9, 10, 12, 13, 15-17 and 19-21, which are dependent from claims 1, 8, 14 and 18, were also rejected under 35 U.S.C. §103(a) as being unpatentable over Burt in view of Heimann. While the Applicant does not acquiesce to the particular rejections to these dependent claims, it is respectfully asserted that these rejections are moot in view of the remarks made in connection with independent claims 1, 8, 14 and 18. These dependent claims include all of the features of the base claims and any intervening claims, and recite additional features that further distinguish these claims from the cited references. In addition, each of the dependent claims recites additional structure, which taken in combination present new and unobvious combinations in their own right. As these claims have never been rejected in their present combination, no further discussion thereof is warranted at this time. Therefore, dependent claims 2-7, 9, 10, 12, 13, 15-17 and 19-21 are also in condition for

allowance. The Applicant respectfully requests that the rejections be withdrawn and the application passed to issue.

CONCLUSION

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. The amendments clarify the patentable invention without adding new subject matter. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

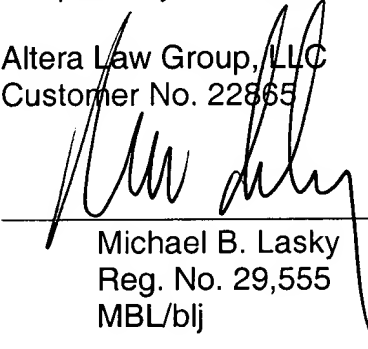
If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Michael B Lasky at (952) 253-4106.

Respectfully submitted,

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By:



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